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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Harry D. Koenig & Co., Inc.

Serial No. 74/042,526

Murray Schaffer of Bauer & Schaffer, LLP, for Harry D.
Koenig & Co., Inc.

Martha L. Fromm, Trademark Examining Attorney, Law Office
106 (Mary Sparrow, Managing Attorney).

Before Cissel, Hanak and Chapman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On Jan. 16, 1996, applicant applied to register the
mark shown below

on the Principal Register for what were subsequently
identified by amendment as "skin soaps, perfumes, and,
pumice stones in Class 3; manicure and pedicure utensils-

namely, scissors, cuticle nippers; tweezers in Class 8; and personal care products-namely, bath brushes, toothbrushes, hair brushes, shaving brushes; scrubbing products-namely, scrubbing pads, mitts, sisal brushes and towels, loofah brushes, pads and gloves; sponges; dispensers, holders, and dishes for soaps and perfume applicators sold empty in Class 21." The application was based on applicant's claim of first use and first use in interstate commerce in February of 1958.

The Examining Attorney refused registration under Section 2(d) of the Act on the ground that applicant's mark, when used on the goods identified in the application, so resembles two registered trademarks that confusion is likely. Both cited registrations are owned by the same individual. The first is for the mark "PHILIP KINGSLEY TRICHOLOGICAL CENTRE," which is registered¹ for a "salon specializing in the treatment of scalp and hair conditions," in Class 42. The second registered² mark cited

¹ Registration No. 1,391,160, which issued to Philip Kingsley, doing business as Philip Kingsley Tricolgical Center, on April 22, 1986; the descriptive terminology "TRICHOLOGICAL CENTRE" is disclaimed apart from the mark as shown; combined affidavit under sections 8 and 15 received and accepted.

² Registration No. 1,389,638, issued in to the same individual on April 15, 1986; combined affidavit under sections 8 and 15 received and accepted.

as a bar to this application is shown below.

This mark is registered for "hair and scalp care preparations and products, namely, hair cream, anti-dandruff cream, hair conditioner, hair spray, hair lotion and scalp treatment," all in Class 3.

The Examining Attorney also refused registration under Section 2(e)(4) of the Lanham Act on the ground that the mark is primarily merely a surname. Submitted in support of this refusal were copies of a number of pages of printouts from the Phonedisc U.S.A. database wherein people whose surname is "Kingsley" are listed.

Further, the Examining Attorney required amendment to the application to identify applicant's goods more precisely. Applicant filed the above-referenced amended version, but the amended identification-of-goods clause still did not satisfy the Examining Attorney that the requirement for specificity had been met. In particular, she found the term "perfume applicators" to be overly broad and suggested that applicant adopt "perfume sprayers and atomizers" instead.

After applicant had responded to the refusals to register and to the requirement for further amendment to the identification-of-goods clause, the Examining Attorney made the refusals and the requirement final.

Submitted in support of the refusal to register based on likelihood of confusion were copies from the U.S. Patent and Trademark Office records of a number of third-party registrations and applications for registration wherein the lists of goods and services with which the marks are used include products of the type listed in the instant application as well as goods and services of the types listed in the cited registrations. Although some of the applications listed do not appear to be based on use, others are. A typical example listed soap, shampoos, hair brushes, perfume sprayers and beauty salon services.

Also submitted with the second Office Action were copies of photographs and magazine advertisements showing the same marks used in advertising hair care and skin care products as well as in connection with salon services.

Applicant then filed a timely Notice of Appeal. Applicant submitted additional evidence with its appeal brief, but the Examining Attorney properly objected to this evidence in her brief, so we have not considered it in resolving this appeal. Trademark Rule 2.142(d).

Applicant requested an oral hearing before the Board, but subsequently withdrew the request. We have therefore resolved this appeal based on the written record presented in the application and the arguments put forward in the briefs.

The issues on appeal are whether the amended identification-of-goods clause is acceptable, in particular whether the term "perfume applicators" is a sufficiently definite statement of what the goods are; whether the mark sought to the registered is primarily merely a surname; and whether applicant's mark, as applied to the goods identified in the application, so resembles the two cited registered marks that confusion is likely.

Turning first to the issue of the acceptability of the identification-of-goods clause, we agree with applicant that "perfume applicators" is an acceptable term for purposes of registration. Applicant's statement that the term is commonly used and understood in reference to its products makes sense. Further, applicant states that it employed the term "applicator" in the application because it wanted to include applicators which have removable tops for directly applying perfume, as well as the "sprayers" and "atomizers" referred to by the Examining Attorney. Applicant should not be required to restrict its goods by

excluding products on which the mark is used, as the language suggested by the Examining Attorney would do. Accordingly, the requirement for a more definite identification-of-goods clause is reversed, and the amended identification of goods is accepted.

The record establishes that the two refusals to register, however, are well taken.

Applicant concedes that its mark is primarily merely a surname, when, at page 7 of its brief, it states "that applicant's mark is no longer merely a surname but has acquired the requisite distinctiveness to delineate origin." Applicant argues that the surname has acquired secondary meaning as a trademark as a result of applicant's use of it since 1958. In her brief, the Examining Attorney does not deny that this might have occurred, and allows that if applicant had submitted such a claim, the refusal would have been withdrawn, but points out that applicant has never submitted a claim of acquired distinctiveness under Section 2(f) of the Act.

We agree. The evidence of record establishes that the primary significance of the term sought to be registered is that of the surname. In the absence of a claim of acquired distinctiveness, the refusal under Section 2(e)(4) must be affirmed.

Turning, then, to the refusal under Section 2(d) of the Act, we find that the Examining Attorney has established that applicant's mark, as applied to the goods set forth in the application, is likely to cause confusion with the two cited registered marks.

The well settled test for determining whether confusion is likely is set forth in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the instant case, applicant's mark is similar to each of the two registered marks, and the goods set forth in the application are commercially related to the goods and services specified in the registrations.

Applicant argues that the marks in question are not the same, but this is not the test. The issue is not whether the marks can be distinguished when they are subjected to a side-by-side comparison. The issue is whether the marks create similar overall commercial impressions. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The emphasis is on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks. *Chemtron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979).

Applicant's mark is a slightly stylized version of the name "Kingsley." This name is the dominant source-indicating component of the registered mark "PHILIP KINGSLEY TRICHOLOGICAL CENTRE." The descriptive terminology "TRICHOLOGICAL CENTRE" has been disclaimed. As such, it does not possess significant source-identifying significance. The name that remains, "PHILIP KINGSLEY," obviously identifies a man who has that name, as does the other cited registered mark, which is simply a stylized version of the combination of the given name and the surname.

A consumer familiar with products sold under a mark consisting of or dominated by the name "PHILIP KINGSLEY" would be reasonable in assuming that similar goods sold under the surname "KINGSLEY" emanate from the same source.

This brings us to a discussion of the relationship between the goods identified in the application and the goods and services set forth in the two cited registrations. In order for confusion to be found likely, these goods and services do not need to be identical or even competitive. They need only be related in some manner, or the conditions surrounding their marketing be such that they would be encountered by the same purchasers under circumstances that could give rise to the mistaken

belief that they are all available from the same source. In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978). Additionally, we note that in resolving whether confusion is likely, we must consider the goods and services as they are identified in the respective application and registrations, without limitations or restrictions that are not reflected therein. In re Elbaum, 211 USPQ 639 (TTAB 1981).

In the instant case, the Examining Attorney has made of record materials which establish that consumers could expect these goods and services to be provided by the same entities. The advertising and magazine articles show that other businesses use their trademarks and service marks on hair care products, skin care products, and in connection with beauty and skin care salon services. Additionally, the third-party use-based registrations of record support the conclusion that a single entity has adopted a single mark for the products and services involved herein. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

Applicant's arguments that its products are not related to the goods and services specified in the cited registrations are not well taken. Applicant's contentions are based, in part, on applicant's statements that the actual trade channels through which its products move are

different from those in which the goods and services specified in the cited registrations travel. Neither the registrations nor the application, however, reflect any such restrictions or limitations. In the absence of such language, we must assume that these goods and services move in all the usual trade channels for such products and services. The third-party registrations and other materials made of record by the Examining Attorney establish that the goods set forth in the application in fact move in the same channels of trade as the goods and services specified in the registrations do. These are all personal care products and services, and they are generally available in beauty salons. When these types of goods and services are provided under similar trademarks, confusion is plainly likely.

Applicant claims that no actual confusion has occurred, but it is well settled that in order to establish that confusion is likely, the Examining Attorney need not prove that confusion has actually occurred. See *Weissgoat asleep Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). The issue is whether confusion is likely, not whether it has taken place.

Applicant also argues that the refusals to register are not proper in this case because applicant once owned a registration for the same mark it now seeks to register. Registration No. 993,441 issued on Sept. 24, 1974, but was not renewed. The cited registrations, as noted above, issued in 1986. Applicant argues that these registrations would not have issued if confusion had been likely.

As the Examining Attorney points out, she is not bound by prior, possibly erroneous, decisions to register particular trademarks. Her responsibility, and ours as well, is to determine registrability based on the record in the case before us.

When we consider the issues presented by this appeal in view of the record established by the Examining Attorney, we conclude that although the requirement for further amendment to the identification-of-goods clause is not appropriate, the refusals to register under Section

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2(d) and Section 2(e)(4) of the Act must be affirmed.

R. F. Cissel

E. W. Hanak

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial & Appeal Board

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